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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/884,779 06/19/01 KLUG

J. 5822.03

020686  
DORSEY & WHITNEY, LLP  
SUITE 4700  
370 SEVENTEENTH STREET  
DENVER CO 80202-5647

TM02/1023

EXAMINER

WANG, M

ART UNIT

PAPER NUMBER

2171

DATE MAILED:

10/23/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**Office Action Summary**

Application No.

09/884,779

Applicant(s)

KLUG ET AL.

Examiner

Mary D. Wang

Art Unit

2171

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Oath/Declaration***

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: it fails to claim the priority dates for the benefit of 60/008,736, filed on 12/11/1995, which is a continuation of 09/128,915, filed on 08/04/1998, which is a continuation of 08/595,837, filed on 02/02/1996.

### ***Priority***

2. This application filed under former 37 CFR 1.62 lacks the necessary reference to the prior application. A statement reading "This is a continuation of Application No. 08/595,837, filed 02/02/1996 and 09/128,915, filed 08/04/1998." should be entered following the title of the invention or as the first sentence of the specification. Also, the current status of the parent nonprovisional application(s) should be included.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. Claims 1, 3-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Chen et al., U. S. Patent 5,590,197.

As to claim 1, Chen teaches a method for registering a user at a plurality of user requested nodes of a communications network wherein nodes of the network are identified using an Internet address scheme, comprising (Fig. 1):

- a) First storing registration information related to the user in a first data store on a first node of said network (column 3 line 33 – column 7 line 9);
- b) Second storing of said registration information in a second store on a second node of said network, said second node being different from said first node (column 3 line 33 – column 7 line 9);
- c) Providing the user with a user identification code permitting access to said registration information in at least one of said first and second stores (column 3 line 33 – column 7 line 9);
- d) Supplying to at least one requested node of said plurality of requested node (column 3 line 33 – column 7 line 9):
  - i. Said user identification code for registering the user at said at least one requested node, and
  - ii. Said registration information transmitted from one of said first and second stores for registering the user at said at least one requested node.

As to claim 3, Chen teaches said communications network utilizes an internet protocol (column 3 line 33 – column 7 line 9 and Fig. 1).

As to claim 4, Chen teaches providing a modification to said registration material on one of said first and second stores to the other of said first and second stores (column 3 line 33 – column 7 line 9).

As to claim 5, Chen teaches retaining said modification in said first and second stores, wherein said modification is transmitted to said at least one requested node in said step of supplying from one of said first and second stores (column 3 line 33 – column 7 line 9).

As to claim 6, Chen teaches said first step of storing includes inputting said registration information by the user (column 3 line 33 – column 7 line 9).

As to claim 7, Chen teaches said second step of storing includes transmitting said registration information from said first node to said second node using said communication network.

As to claim 8, Chen teaches inputting user identification from said first node; transmitting said user identification to said node; and using said user identification at second node for determining said user identification code (column 3 line 33 – column 7 line 9).

As to claim 9, Chen teaches requesting by said at least one requested node, said registration information from said second node (column 3 line 33 – column 7 line 9).

Claims 10-11 are rejected for the similar reason as claim 1, which was discussed above.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al., U. S. Patent 5,590,197 in view of Johnson et al., U. S. Patent 5,813,009.

As to claim 2, Chen teaches said first node is a server node and said second node is a client node (column 3 line 33 – column 7 line 9).

The difference between the present application and the teach of Chen is following:

*Chen teaches storing the registration information on the server first, and then storing the registration information on the user side. The present application claims the registration information is stored on the client side first, and then the server side.*

Johnson teaches storing registration information on the client side first, and then the server side (column 23 line 55-65).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow Chen's registration information to be stored in on the user

said first and one the server side thereafter because it will be efficient to process the updated registration information.

### ***Double Patenting***

8. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

9. Claims 1-11 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-11 of prior U.S. Patent No. 5,790,785. This is a double patenting rejection.

10. Claims 1-11 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-11 of prior application No. 08/128,915. This is a double patenting rejection.

***Inquire***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Wang whose telephone number is (703)-305-0084. The examiner can normally be reached on Monday – Thursday from 8:00 AM to 5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Black, can be reached on (703) 305-9707.

The fax phone number for the organization where this application or proceedings is assigned are as follows:

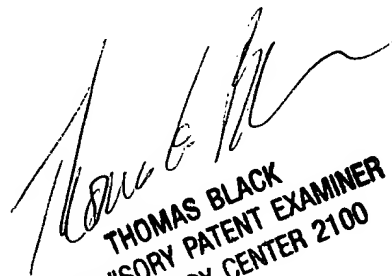
(703) 746-7238 (After Final Communication)

(703) 746-7239 (Official Communications)

(703) 746-7240 (For Status inquiries, draft communication)

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-3900.

Mary Wang  
Patent Examiner  
Art Unit 2171  
October 9, 2001

  
THOMAS BLACK  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100